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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,198	10/31/2001	Jeffrey Erdfarb	12186/1	4144
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KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				COHEN, AMY R
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/003,198	ERDFARB, JEFFREY
	Examiner Amy R. Cohen	Art Unit 2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 April 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 13-18 and 31 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 13-18 and 31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 31 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first set of indicia located on a first side and a second set of indicia located on a second side of the tape, wherein the first side is a front side and the second side is a back side (as argued by Applicant); and wherein the second side includes a third set of indicia must be shown or the feature(s) canceled from the claim(s).

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

2. Claim 13 objected to because of the following informalities:

Claim 13 appears to be incomplete since “wherein” appears directly before the period ending the sentence. For purposes of prosecution, Examiner interprets the claim language to not include the term “wherein”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 13-18, 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook (U. S. Patent No. 6,237,243).

Cook teaches a tape measuring device (10) for determining a first distance, the first distance being related to a first dimension measured on a drawing depicting features at a first scaling ration, the measuring device comprising: a first set of indicia (22) comprising marks spaced at intervals matching a common system of units and located on a first side of a tape of the tape measuring device (Fig. 1, Col 3, lines 43-54); a second set of indicia (44) comprising marks spaced at intervals correlating to the common system of units, wherein the value of the units of the second set of indicia correspond to the value of the units of the first set of indicia by the

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inverse of the first scaling ratio, said second set of marks located on a second side of the tape (Figs. 3-5, Col 4, lines 4-19).

Cook teaches the tape measuring device further adapted for laying out a second distance, wherein when the second distance is related to a second dimension measured on a second drawing depicting features at a second scaling ratio, comprising a third set of indicia (46) comprising marks spaced at intervals correlating to the common system of units wherein the value of the units of the third set of indicia correspond to the value of the units of the first set of indicia by the inverse of the second scaling ratio, said third set of marks located on the second side of the tape (Figs. 3-5, Col 4, lines 4-19).

Cook teaches the tape measuring device comprising a housing (12) in which the tape is stored (Fig. 1).

Cook teaches the tape measuring device wherein the first set of indicia comprises numerical values and the second set of indicia comprises numerical values (Figs. 1, 3, 5, Col 3, lines 43-54, Col 4, lines 4-19).

Cook teaches the measuring device wherein the second and third set of indicia have a starting point adjacent to each other (Figs. 3-5, Col 4, lines 4-19).

Cook teaches the tape measuring device wherein the first scaling ratio corresponds to one of an engineering and architectural scale (Figs. 3-5, Col 4, lines 4-19).

Cook teaches a tape measurement device for determining a size of a feature on a building plan, the device comprising: a tape (18, 20) having a first side and a second side, each side having a first and a second edge (Figs. 1-5); a first set of regularly spaced marks (22) along a first edge of the first side, the marks denoting fractions of and whole inches, and usable for

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laying out dimensions of building material for building according to the building plan (Fig. 1, Col 3, lines 43-54); a second set of regularly spaced marks (44) located on a first edge of the second side of the tape, the marks including indicia at regular intervals of marks, said indicia relate the second marks to the first marks by a scale ratio (Figs. 3-5, Col 4, lines 4-19), wherein said scale ratio on said plans and measurement of the feature on said building plan using said second set of marks indicates a dimension of said feature to be built using said first set of marks (Figs. 3-5, Col 4, lines 4-19).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-18, 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horning (U. S. Patent No. 1,235,801) in view of Simmons (U. S. Patent No. 5,884,408).

Regarding claims 13-18, 23, 29, 30: Horning discloses a measurement device for determining a first distance being related to a first dimension measured on a drawing depicting features at a first scaling ratio, the measurement device comprising: a first set of indicia (D) comprising marks spaced at intervals matching a common system of units and located on a first side (A) of a measuring device (Fig. 1, Col 1, lines 37-49); a second set of indicia (L) comprising marks spaced at intervals correlating to the common system of units, wherein the value of the units of the second set of indicia correspond to the value of the units of the first set of indicia by

the inverse of the first scaling ratio, said second set of marks located on a second side of the measuring device (Fig. 1, Col 2, lines 78-105).

Horning discloses the measuring device adapted for laying out a second distance, wherein when the second distance is related to a second dimension measured on a second drawing depicting features at a second scaling ratio, comprising a third set of indicia (M) comprising marks spaced at intervals correlating to the common system of units wherein the value of the units of the third set of indicia correspond to the value of the units of the first set of indicia by the inverse of the second scaling ration, said third set of marks located on the second side of the measuring device (Fig. 1, Col 2, lines 78-105); wherein the first set of indicia comprises numerical values and the second set of indicia comprises numerical values (Fig. 1, Col 1, lines 37-49, Col 2, lines 78-105); wherein the second and third set of indicia have a starting point adjacent to each other (Fig. 1, Col 2, lines 78-105); wherein the first scaling ratio corresponds to one of an engineering and architectural scale (Col 1, lines 9-17, Col 2, lines 78-105, Col 3, lines 4-24).

Horning does not disclose the measuring device comprising a housing in which the tape is stored; wherein the measuring device is a tape measuring device.

Simmons discloses a measuring device comprising a housing (30) in which the tape is stored; wherein the measuring device is a tape measuring device (Col 2, lines 1-11, Col 2, line 60-Col 3, line 23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the measuring device of Horning be a tape measuring device, as taught by Simmons, since Simmons discloses that a flat ruler and a tape measure are different but

equivalent means of providing measurement indicia for measuring objects (Simmons, Col 2, lines 1-11, Col 2, line 60-Col 3, line 23).

Regarding claim 31: Horning discloses a measurement device for determining a size of a feature of a building plan, the device comprising: a measurement device having a first side and a second side (Fig. 1), each side having a first and second edge (Fig. 1); a first set of regularly spaced marks (D, E) along a first edge of the first side (Fig. 1, Col 1, lines 37-49), the marks denoting fractions of an whole inches (Fig. 1, Col 1, lines 37-49), and usable for laying out dimensions of building material for building according to the building plan (Col 1, lines 9-17, Col 3, lines 4-24); a second set of regularly spaced marks (L, M) located on a first edge of the second side of the measurement device (Fig. 1, Col 2, lines 74-105), the marks including indicia at regular intervals of marks (Fig. 1, Col 2, lines 74-105), said indicia relate the second set of marks to the first set of marks by a scale ratio (Fig. 1, Col 2, lines 74-105), wherein said scale ratio corresponds to a scale ratio on said plans and measurement of the feature on said building plan using said second set of marks indicates a dimension of said feature to be built using said first set of marks (Col 1, lines 9-17, Col 3, lines 4-24).

Horning does not disclose the measuring device wherein the measuring device is a tape measuring device.

Simmons discloses a measuring device wherein the measuring device is a tape measuring device (Col 2, lines 1-11, Col 2, line 60-Col 3, line 23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the measuring device of Horning be a tape measuring device, as taught by Simmons, since Simmons discloses that a flat ruler and a tape measure are different but

equivalent means of providing measurement indicia for measuring objects (Simmons, Col 2, lines 1-11, Col 2, line 60-Col 3, line 23).

***Response to Arguments***

7. Applicant's arguments filed April 23, 2007 have been fully considered but they are not persuasive.
8. Regarding Applicant's arguments that Horning and Simmons do not teach a tape measuring device with a first set of indicia on one side and a second set of indicia on a second side, Examiner disagrees. Applicant is reminded that the claims are interpreted in the broadest sense and given the broadest reasonable meaning. In this case, a first side of a tape can refer to a left side and a second side refers to a right side. It is noted that there are no other structural limitations regarding the sides of the tape, as claimed by Applicant, except that there be a first side and a second side. Therefore, the rejection of the claims over Horning and Simmons is repeated above. In addition, in light of Applicant's arguments, a rejection based on Applicant's interpretation of the terms "first side" and "second side" in view of Cook, is stated above in paragraph 4.
9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir.

1992). In this case, Horning teaches a ruler measuring device and Simmons teaches that a measuring device can take the form of a ruler or a tape measure. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the measuring device of Horning be a tape measuring device, as taught by Simmons, since Simmons discloses that a flat ruler and a tape measure are different but equivalent means of providing measurement indicia for measuring objects (Simmons, Col 2, lines 1-11, Col 2, line 60-Col 3, line 23).

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Horning teaches a measuring device comprising a first set of indicia matching a common system of units and a second set of indicia correlating to the common system of units, wherein the value of the second set of indicia correspond to the value of the units of the first set of indicia by the inverse of the first scaling ratio, and since Simmons teaches that a measuring device can take the form of a ruler or a tape measure. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the measuring device of Horning be a tape measuring device, as taught by Simmons, since Simmons discloses that a flat ruler and a tape measure are different but equivalent means of

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providing measurement indicia for measuring objects (Simmons, Col 2, lines 1-11, Col 2, line 60-Col 3, line 23).

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy R. Cohen whose telephone number is (571) 272-2238. The examiner can normally be reached on 8 am - 5 pm, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ARC  
June 29, 2007

*D. Bradley Bennett*  
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